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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,743	01/11/2002	John W. Ladd	4584.2US (00-0787.2)	3846
24247	7590	09/23/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			CHANG, RICK KILTAE	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/044,743

Applicant(s)

LADD, JOHN W.

Examiner

Rick K. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/2/05 has been entered.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/035,738. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combinations of Claims 1 and 5 and Claims 8 and 13 are generic to the species of invention covered by claims 1 of the copending application. The combination of Claims 1 and 5 contains the steps of "establishing an electrical contact between a first member of an electrical connector and a contact that is in electrical

communication with the at least one semiconductor device, and magnetically drawing the first member toward the contact". The same is true for the combination of Claims 8 and 13. The generic inventions of Claims 1 and 5 and Claims 8 and 13 are "anticipated" by the species of the copending invention. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Furthermore, the copending application contains the terms "temporary electrical contact" which is not supported by the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umbaugh (US 3,855,693).

Umbaugh discloses effecting a magnetic drawing by positioning a second member 20 of a contact 37 toward a first member 36 with a second member 14, except for effecting the magnetic drawing by positioning a second member opposite the first member toward the contact. It would have been obvious to one having ordinary skill in the art at the time the invention was made to effect the magnetic drawing by positioning the second member 14 opposite 36 toward 37, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Umbaugh discloses in Fig. 4 a plurality

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of chips making connections and they all inherently and obviously require power and ground contacts, as well as constant amount of current.

6. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umbaugh (US 3,855,693) as applied to claims 1-9 and 14-17 above, and further in view of Butherus et al (US 3,612,955).

Umbaugh fails to disclose providing a second member opposite the substrate from the first member and magnetically drawing the first and second members to other first and second members.

Butherus discloses in Figs. 1B and 2 a semiconductor device 59 surrounded with ferromagnetic materials, as well as second member 45 and 46, to provide attraction both vertically and laterally (col. 3, lines 2-3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Umbaugh by providing a second member opposite the substrate from the first member and magnetically drawing the first and second members to other first and second members, as taught by Butherus, for the purpose of saving space for other electronic components.

7. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umbaugh (US 3,855,693) as applied to claims 1-9 and 14-17 above, and further in view of Official Notice.

Umbaugh teaches the invention as described with respect to the claims above. Umbaugh fails to disclose heating either cyclically or variously.

Official Notice is taken that it is well known in the art to provide heat during burn-in testing either cyclically or variously to purposely fail the component.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Umbaugh by heating either cyclically or variously, as taught by Official Notice, for the purpose of purposely failing the components.

***Response to Arguments***

8. Applicant's arguments with respect to claims 1-9 and 11-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. **Please provide reference numerals (either in parentheses next to the claimed limitation or in a table format with one column listing the claimed limitation and another column listing corresponding reference numerals in the remark section of the response to the Office Action) to all the claimed limitations as well as support in the disclosure for better clarity (optional). Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick K. Chang whose telephone number is (571) 272-4564. The examiner can normally be reached on 5:30 AM to 1:30 PM, Monday through Thursday.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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A handwritten signature in black ink, consisting of several loops and a long horizontal stroke at the end.

**RICHARD CHANG  
PRIMARY EXAMINER**

RC  
September 21, 2005